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07/22/2003TTAB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

BIG O TIRES, INC.

Opposer,

v.

SUNRISE INCORPORATED,

Applicant.

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Opposition No.



06-27-2003

U.S. Patent & TMOfc/TM Mail Rcpt Dt. #74

NOTICE OF OPPOSITION

In the matter of an application to register a trademark under the Trademark Act of 1946, Serial No. 78/115,902, filed March 19, 2002, in the name of Sunrise Incorporated, published for opposition in the Trademark Official Gazette of October 8, 2002, Vol. 1263, No. 2, at page TM 426, for the mark BIG O, the Opposer, Big O Tires, Inc., believes it will be damaged by registration of said alleged trademark and hereby opposes same. The grounds for opposition are as follows:

1. The Opposer, Big O Tires, Inc. [hereinafter "Big O"], is a corporation duly organized and existing under the laws of the State of Nevada and having its place of business at 12650 East Briarwood Avenue, Englewood, Colorado 80112. Opposer markets, distributes and sells a variety of products and accessories, and provides retail store and franchise services.

COUNT I - LIKELIHOOD OF CONFUSION

2. Commencing prior to the date of first use of the application opposed herein, Opposer has, and is now, engaged in the distribution and sale of products, retail store, franchise and other services, in commerce in the United States, under and in connection with the trade name(s) and trademark (s) **BIG O** and **BIG O TIRES** [collectively, Opposer's "**BIG O**" Mark]. Opposer Big O

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continuously has used said Opposer's **BIG O** Mark in commerce in connection with Opposer's retail stores and products and services, produced, advertised, offered for sale, and sold by Big O, and to identify and designate same, and to distinguish those goods, services and business from those of others.

3. Opposer Big O is the owner of, and will rely on herein, the following U.S. trademark registrations:

<i>REGISTRATION NO.</i>	<i>ISSUE DATE</i>
2,514,975	December 4, 2001
2,411,926	December 12, 2000
1,611,160	August 28, 1990
994,466	October 1, 1974
993,415	September 24, 1974

Said registrations are valid and subsisting, and constitute *prima facie* and/or conclusive evidence of Opposer Big O's ownership of Opposer's **BIG O** Mark, and exclusive right to use same in commerce in connection with the goods and services set forth in said registrations.

4. Since Opposer's initial use of Opposer's **BIG O** Mark, Big O has used, and advertised, produced and offered its goods, services, stores and business under and in connection with said mark to the public, through various channels of trade, and in commerce, with the result that Opposer's customers and the public in general have come to know and recognize said mark of Opposer and associate same with Opposer and/or the goods and services produced, advertised, marketed, distributed, and sold directly or indirectly by Opposer Big O, Opposer's business and/or stores. Opposer thus has built up goodwill in connection with the sale of its products and services under Opposer's **BIG O** Mark.

5. On March 19, 2002, Applicant filed an application to register the mark BIG O. Said application was accorded serial no. 78/115,902, and was published for opposition in the Official Gazette of October 8, 2002, at page TM 426, identifying the goods as "pre-recorded videotapes and DVDs featuring animated stories."

6. The BIG O mark sought to be registered by Applicant is identical to Opposer's prior and aforesaid **BIG O** Mark.

7. On information and belief, the goods set forth in the application opposed herein are the same, similar and/or related to, the services and goods in connection with which Big O uses Opposer's **BIG O** Mark, and on information and belief, the goods set forth in the opposed application are and/or will be sold through the same and/or similar channels of trade, and/or to the same general class of purchasers, in and to which Big O's products, services and business are marketed and/or sold.

8. The registration and/or use of the BIG O mark, as set forth in the opposed application, is likely to cause confusion, mistake, and/or to deceive as to origin, sponsorship, and/or association of Applicant's goods sold under the BIG O mark sought to be registered by Applicant vis-a-vis Opposer and/or its **BIG O** Mark, and/or to mislead purchasers of Applicant's and/or Opposer's goods and/or services, and/or the public in general, into believing that Applicant's goods are sold by, emanate from, and/or in some way, directly or indirectly, are associated with Big O, and/or Opposer's **BIG O** Mark, products, services, stores and/or business, or vice versa, to the damage and detriment of Big O.

9. By virtue of the foregoing, Big O believes it will be damaged by the use and registration by Applicant of the BIG O mark, as set forth in the application therefor, serial no. 78/115,902.

COUNT II - DILUTION

10. Opposer restates and realleges ¶¶1-9, inclusive, above, of this Notice of opposition, and hereby incorporates same as if fully set forth herein.

11. Since prior to the date of first use alleged in the application opposed herein, Opposer's **BIG O** Mark has been, and is, distinctive and/or famous.

12. On information and belief, the registration and/or commercial use of the opposed BIG O mark by Applicant will cause dilution of the distinctive quality of Opposer's aforesaid famous and distinctive **BIG O** Mark and name.

13. If Applicant is granted the registration opposed herein, and Applicant obtains such rights as conferred under the Principal Register of the Trademark Act of 1946, Applicant will obtain unlawful gain and advantage to which they are not entitled under the Trademark Act of 1946, to the detriment and harm of Opposer.

WHEREFORE, this Opposer, Big O Tires, Inc., believes and alleges that it will be damaged by registration of the BIG O mark of application serial no. 78/115,902, as aforesaid, and prays that:

1. judgment in the present opposition be entered in favor of Opposer on Counts I and II, inclusive, of this Notice of opposition;
2. the present opposition be sustained; and
3. registration of application serial no. 78/115,902 be rejected and refused.

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Respectfully submitted,

BIG O TIRES, INC.

By:



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Date: June 27, 2003

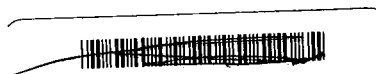
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June 27, 2003



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U.S. Patent & TMOtc/TM Mail Rcpt Dt. #74

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

RE: New Opposition
Big O Tires, Inc. v. Sunrise Incorporated
BIG O - Serial No. 78/115,902
Our Ref.: 11386/I-4799

Sir:

We enclose the following for filing in the Patent and Trademark Office:

- ☒ Notice of Opposition (in duplicate)
☐ Notice of Appeal

Also enclosed is our check for the required filing fee in the amount of \$300.00. Should this check become detached, or the amount be insufficient, please charge our Deposit Account, No. 06-1358.

Respectfully submitted,

Marsha G. Gentner

MGG/tlb
Enclosures